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10/776,336	02/12/2004	Tatiana L. Gelardi	SAGOMA	1734

7590

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EXAMINER

FRANCIS, FAYE

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/776,336

Applicant(s)

GELARDI, TATIANA L.

Examiner

Faye Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, graphics and the graphic surfaces, in claims 5, 12 and 19 respectively must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5, 7-10, 12, 14-17 and 19 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Schluger [5,682,990].

Schluger discloses in Figs 1-8, forming a book format package [Fig 2] comprising: providing a cover [holder 16], providing the cover with a rigid front 20 and a rigid back 22 [as shown in Fig 4 the cover is made out of layers of cardboard panels 26, 28. Also note the application's specification page 5 second paragraph, where the applicant considers layers of cardboard material as being rigid], providing a flexible spine [spine 30 with fold lines 32] disposed between the rigid front and the rigid back, providing a rigid tray [container 12 and box 48], providing a binding material adhesive placed on the flexible spine and attaching the tray to the cover at the flexible spine 30 [col 2 line 51-52] as recited in claims 1, 8 and 15. Additionally, Schluger discloses wrapping the rigid front and rigid back around opposite sides of the rigid tray [Fig 8] as recited in claim 2, holding compact discs 14 in the tray as recited in claim 3 and providing graphic surfaces [col 3 lines 14-19] coverings on the rigid front and the rigid back as recited in claims 5, 12 and 19. Furthermore, Schluger discloses the front and back lie against opposite front and rear surfaces of the tray [Fig 8] as recited in claim 9.

With respect to the curing step of adhesive in claim 1, the heating step to about 150 C for curing the adhesive in claim 7 and heating step for curing the adhesive in claim 14 are considered to be process steps in product claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) [see MPEP 2113 regarding how product by process claims re treated in claims].

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6-11 and 13-18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Roze [4,823,950] in view of Fraser et al. [6,523,683], hereinafter Fraser.

Roze discloses in Figs 1-5, forming a book format package 10 comprising: providing a cover with a rigid front and a rigid back [cover 50 and planar members 25 and 45] and [col 4 lines 8-13], providing a flexible spine [securing member 60] disposed between the rigid front and the rigid back [Fig 2], providing a rigid tray [frames 20, 30

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and 40] as recited in claims 1, 8 and 15. Additionally, Roze discloses wrapping the rigid front and rigid back around opposite sides of the rigid tray [Fig 1] as recited in claim 2, holding compact discs in the tray [Fig 2] as recited in claim 3, holding compact discs on the front and back [Fig 2] as recited in claim 4. Furthermore, Roze discloses the front and back lie against opposite front and rear surfaces of the tray [Fig 8] as recited in claim 9. Please note that claims 1, 7 and 14 are product by process claims.

Although Roze discloses attaching the tray to the cover at the flexible spine [col 3 lines 25-34], Roze is silent how this has been done [what kind of material has been used].

Fraser teaches that it is conventional and desirable in a data carrying containers to utilize heat-cured adhesive as a bounding material. It would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of Fraser to utilize the heat-cured adhesive as a bounding material to attach the tray to the cover at the flexible spine in the device of Roze in order to provide a strong bounding connection between the cover and the tray [supper adhesive].

With respect to the curing step of adhesive in claim 1, the heating step to about 150 C for curing the adhesive in claim 7 and heating step for curing the adhesive in claim 14 are considered to be process steps in product claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior

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product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) [see MPEP 2113 regarding how product by process claims are treated in claims].

6. Claims 5, 12 and 19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Roze in view of Fraser as applied to claims 1-4, 6-11 and 13-18 above and further in view of Schluger.

Modified device of Roze has most of the elements of these claims but for providing graphic surfaces on the rigid front and the rigid back.

Schluger teaches the concept of providing graphic surfaces on the cover of a CD holder [col 3 lines 14-19]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further provide the cover in the modified device of Roze with the graphic surfaces as taught by Schluger in order to display information covering text.

7. Claim 20 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Roze in view of Fraser as applied to claims 1-4, 6-11 and 13-18 above and further in view of Schluger.

Modified device of Roze has most of the elements of this claim.

Modified device of Roze does not have heating the binding material adhesive and curing the binding material adhesive.

Schluger already teaches the general condition of utilizing adhesive to attach the tray to the cover at the flexible spine. Moreover, selection of a known material based upon its suitability for the intended use thereof generally will not support patentability. In

re Leshin, 125 USPQ 416. Accordingly, it would have been obvious in view of these reasons, to further utilize any suitable adhesive including the particular adhesive as claimed by the applicant to attach the tray to the cover at the flexible spine in order to provide a supper adhesive.

### ***Response to Arguments***

8. Applicant's arguments filed 6/8/05 have been fully considered but they are not persuasive.

In response to applicant's argument on page 8 that nothing in Schluger describes, teaches, or suggests the claimed package with a plurality of trays and each tray attached to a flexible spine so that any number of storage media can be accommodated between the front and back covers of the book format package. The examiner would like to point out that claims 1-3, 5, 7-10,12, 14-17 and 19 do not require "a plurality of trays". The examiner agrees that Schluger does not anticipate claims 6 and 13. However, this has been a typing error, claims 6 and 13 should have not been included in the rejection by the examiner [note the rejection in paragraph 6 of last prvious office action that does not address claims 6 and 13.

In response to applicant's argument on page 10 regarding the rejection of claims 1-4, 6-11 and 13-18, the examiner would like to point out that Fraser reference has been applied only to show that it is conventional and desirable in a data carrying containers to utilize heat-cured adhesive as a bounding material.

The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the



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proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re Simon, 174 USPQ 114 (CCPA 1972); In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

The question under 35 USC §103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); In re Dillon, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990); In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976); In re Wilder, 429 F.2d 447, 166 USPQ 545 (CCPA 1970). In this case, the artisan would have been motivated to utilize the heat-cured adhesive as a bounding material to attach the tray to the cover at the flexible spine in the device of Roze in order to provide a strong bounding connection between the cover and the tray.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 571-272-4423. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF

  
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